

R E M A R K S

Claims 9, 10, 14 to 17 and 21 to 33 as set forth in Appendix I of this paper are now pending in this case. Claims 22 to 33 have been added as indicated.

Applicants have added Claims 22 to 25 to further bring out the embodiments of applicants' invention wherein mica is employed in amounts of from 0.15 to 3% by weight, based on the total weight of the components used. The respective embodiments are addressed on page 3, indicated lines 19 to 22, of the application. New Claims 26 to 33 are drawn to embodiments of the subject matter defined in Claims 9, 15, 17 and 21 to 25 wherein the amount of other conventional auxiliaries and fillers (E) is from 0 to 15 parts by weight as disclosed on page 3, indicated lines 25 to 27, of the application. No new matter has been added.

The Examiner indicated in the PTO-326 form that Claims 9 to 21 were pending. It is respectfully solicited that the Disposition of Claims be corrected and updated, taken into account that Claims 11 to 13 and 18 to 20 were canceled by applicants in their reply dated June 25, 2004, which was entered by the Examiner as indicated in the Advisory Action which issued on July 19, 2004.

The Examiner rejected Claims 9 to 21 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Farber et al.* (US 3,951,906), arguing that *Farber et al.* showed compositions which comprise styrene-acrylonitrile copolymers in combination with mica in claim 12 as well as in col. 2 of US 3,951,906<sup>1</sup>).

With regard to Claims 9, 10, 14 to 17 and 21 as well as newly added Claims 22 to 33 it is respectfully urged that applicants' invention is distinguished from the teaching of *Farber et al.* not only due to applicants' requirement concerning the proportion of acrylonitrile in the styrene-acrylonitrile copolymers as acknowledged by the Examiner. The subject matter defined in applicants' claims is further distinguished from the teaching of *Farber et al.* due to applicants' requirement that the mica content of the compositions referenced in applicants' claims be from 0.05 to 5 parts by weight and from 0.15 to 3 parts by weight, respectively.

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1) The rejection is deemed to be moot to the extent that Claims 11 to 13 and 18 to 20 are referenced because those claims are no longer pending in this case.

Claim 12 of **Farber et al.** defines a composition which comprises, as component (B) "between about 20% and 30% mica"<sup>2)</sup>, which is at least four times the amount of mica which is incorporated in accordance with applicants' invention as defined in Claims 9, 10, 14 to 17, 21 and 26 to 29, and more than 6 times the amount of mica which is incorporated in accordance with applicants' invention as defined in newly added Claims 22 to 25 and 30 to 33. Also, the disclosure of **Farber et al.** in col. 2<sup>3)</sup> merely provides a generic reference that a broad range of particulate fillers may be incorporated into the styrene-acrylonitrile materials in combination with glass fibers. The examples of particulate fillers which are enumerated by **Farber et al.** in this context are<sup>4)</sup>

charcoal, graphite, aluminum, iron oxide, calcium carbonate, silica, alumina, talk, clay, limestone, etc.

Mica is neither mentioned in this context nor in any other context in the description part of **US 3,951,906**. **Farber et al.** further state that the particulate fillers mentioned in col. 2 are incorporated in amounts of from 5% to 65% by weight<sup>5)</sup> preferably from 10 to 30% by weight<sup>6)</sup>, and provide illustrative examples in which  $\text{Fe}_2\text{O}_3$ , charcoal or  $\text{CaCO}_3$  are employed in amounts of 15% and 25% by weight, respectively<sup>7)</sup>.

In light of the distinct differences between the styrene-acrylonitrile compositions which are shown by **Farber et al.** and the compositions which are referenced in applicants' claims the Examiner's position is not deemed to be well taken that the improved chemicals resistance which is achieved in accordance with applicants' invention is inherent in the compositions of **Farber et al.** The Examiner's assertion is clearly based on a determination where information which is made available only through applicants' invention is used against the applicants. Such a determination is, however, fraught with error because it is based on hindsight and on an uncorroborated assumption that the particular effect which is achieved in accordance with applicants' invention can be achieved when any particulate filler is

2) Cf. col. 8, indicated lines 24 and 25 of **US 3,951,906**.

3) Cf. in particular col. 2, indicated lines 31 to 48, of **US 3,951,906**. The remaining sections of col. 2 address the styrene-acrylonitrile thermoplastics and the glass fibers of **Farber et al.**'s reinforced materials.

4) Cf. col. 2, indicated lines 35 to 38, of **US 3,951,906**.

5) Cf. col. 3, indicated lines 15 to 18, of **US 3,951,906**.

6) Cf. col. 3, indicated lines 25 to 28, of **US 3,951,906**.

7) Cf. Tables 1 to 4, cols. 4 to 6, of **US 3,951,906**.

incorporated in any amounts into any styrene-acrylonitrile polymer composition<sup>8</sup>).

Moreover, for a finding of obviousness under Section 103(a) the prior art has to suggest or convey the invention as a whole to a person of ordinary skill, and the invention as a whole includes the properties which are achieved in accordance with the invention not only where the claims define a method<sup>9</sup>) but also where the claims define a composition<sup>10</sup>). The teaching of *Farber et al.* contains nothing which would suggest or imply that the chemicals resistance of styrene-acrylonitrile materials in general, or -more particularly- of styrene-acrylonitrile materials which have a proportion of acrylonitrile of from 10 to less than 28% by weight, can be influenced in any way. The teaching of *Farber et al.* therefore neither suggests or conveys to a person of ordinary skill in the art that it is possible to improve the chemicals resistance of styrene-acrylonitrile materials in general by incorporating any kind of particulate filler in any amount. The teaching of *Farber et al.* is accordingly even less suited to suggest or convey to a person of ordinary skill that the chemicals resistance of styrene copolymers, in particular styrene-acrylonitrile materials which have an acrylonitrile content of from 10 to less than 28% by weight, can be improved by incorporating mica, in particular in amounts of from 0.05 to 5, or amounts of from 0.15 to 3, parts by weight. The teaching of *Farber et al.* therefore falls short from suggesting or conveying applicants' invention as a whole to a person of ordinary skill, and is insufficient to support a conclusion that applicants' invention was *prima facie* obvious within the meaning of Section 103(a) at the time the invention was made. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 103(a) based on the teaching of *Farber et al.* is, therefore, respectfully solicited.

8) Cf. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 230 USPQ 303 312-313 (CAFC 1983): "To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein which only the inventor taught is used against the teacher."; In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (CAFC 1988); Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (CAFC 1986).

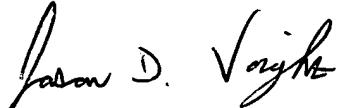
9) Cf. In re Dillon, 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (CAFC 1990) (*en banc*), cert. denied, 500 U.S. 904 (1991).

10) Cf. In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977).

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Respectfully submitted,

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Encl.: THE LISTING OF CLAIMS (Appendix I)

JDV/BAS